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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,404	08/02/2001	Berardino Salvatore	GB9-2000-0088-US1	5864

7590 04/07/2004  
IBM Corp  
IP Law  
11400 Burnett Road, Zip 4054  
Austin, TX 78758

EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 04/07/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/920,404

Applicant(s)

BERARDINO SALVATORE

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This Office Action is in response to the patent application (09/920,404) filed on August 2, 2001.

### **Priority**

2. The present patent application claims priority from Foreign (GB) Application No. 0104760.4 filed February 24, 2001.

### **Status of the claims**

3. The pending claims 1-6 are examined as follows:

### **Specification**

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --Positioning a Window on a Graphical User Interface--.

5. The abstract of the disclosure is objected to because it exceeded the one paragraph limit. Correction is required. See MPEP § 608.01(b).

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 4 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 4 recites "a computer program including program code," a computer program or a program code *per se* does not fit any of the four statutory classes of invention. The invention itself is nothing more than a collection of program code. Thus, the invention fails the test for whether it is a specific "machine, process, or article of manufacture." Similarly claim 5 recites "a window oriented operating system including program code," a program code *per se* does not fit any of the four statutory classes of invention. The invention itself is nothing more than a collection of program code. Thus, the invention fails the test for whether it is a specific "machine, process, or article of manufacture"

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka (US 5,249,296).

The present invention is directed to positioning a new window on the desktop, wherein before opening a new window, a user can select an area on the desktop where the window will be displayed, so that the user can decide which windows or portion of windows must be visible after the new window is displayed on the desktop.

Tanaka is also directed to do the same (abstract, column 6, lines 1-12).

With regard to claim 1:

Tanaka discloses a computer system (Fig. 2) having a graphic user interface (e.g. Fig. 8) for displaying a plurality of objects on a desktop (e.g. Fig. 8), a method for controlling the displaying of new objects (e.g. Figs. 8 and 9, K) on the desktop includes the steps of detecting a user request for displaying a new object on the desktop (Fig. 7, column 5, lines 29-68);

the method also includes responsive to user selection (Fig. 7, column 5, Lines 29-68), determining a target area (e.g. Figs. 8 and 9, K) on the desktop;

the method further includes displaying the new object within the target area (e.g. Figs. 8 and 9, K column 6, lines 1-12).

With regard to claim 2:

Tanaka further discloses a rectangular target area (e.g. Figs. 8 and 9, K), and the user selection includes selecting a first corner of the target area (e.g., Fig. 8, K); and selecting the corner opposite to the first corner (e.g., Fig. 9, K, column 6, lines 1-12).

With regard to claim 3:

Tanaka further discloses moving a pointer on the desktop by means of a pen or input device (pointing device) (Fig. 2, #1, column 5, Lines 29-68).

With regard to claims 4 and 5:

Independent claims 4 and 5 correspond generally to independent claim 1 and recite similar features in program code form, and therefore are rejected under the same rationale.

With regard to claim 6:

Tanaka discloses a graphical user interface (Fig. 8) includes means for detecting (Pen input, #1) a user request for displaying a new object on the desktop (Fig. 7, column 5, Lines 29-68, column 6, lines 1-12); means for responsive to user selection, determining a target area (Fig. 9, K) on the desktop (Fig. 7, column 5, Lines 29-68, column 6, lines 1-12); means for displaying (Fig. 2, #9) the new object within the target area (Fig. 7, column 5, Lines 29-68, column 6, lines 1-12).

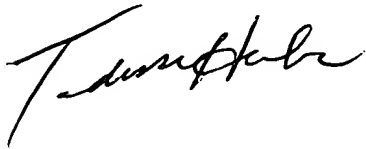
### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 8:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

Art Unit: 2173

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu

A handwritten signature in black ink, appearing to read 'Tadesse Hailu', written in a cursive style.

April 5, 2004